39-5461-2

The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.

Paper No. 42

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Due Date(s): 8/27/03 (Final)

Ex parte TAKANOBU KAMAKURA

Appeal No. 1999-1627
Application No. 08/578,980

Before JERRY SMITH, RUGGIERO,[1] and BLANKENSHIP, Administrative Patent Judges.

BLANKENSHIP, Administrative Patent Judge.

ON REQUEST FOR REHEARING

This is in response to appellant's request that we reconsider our decision mailed February 19, 2002, wherein we sustained the final rejection of claims 1-10. However, appellant's arguments fail to convince us that we erred in any respect in the decision. We therefore decline to make any changes therein.

[1] Administrative Patent Judge Lall retired from the USPTO before this case was reached for rehearing. Legal support for substituting one Board member for another can be found in In re Bose Corp., 772 F.2d 866, 869, 227 USPQ 1, 4 (Fed. Cir. 1985).

Appellant reargues a point that we addressed on page 4 of the opinion, in which we noted that the instant claims do not preclude reading layers 31, 29, and that portion of layer 25 between strain layer 27 and active region 29 (Scifres Fig. 2) as the hetero-configuration light emitting device. Appellant appears to hold that, because Scifres refers to both portions of layer 25 surrounding strain layer 27 as "cladding layer 25," the artisan would not have considered a combination that includes the uppermost portion of layer 25 as meeting the terms of the claims.

For a prior art reference to anticipate in terms of 35 U.S.C. § 102, every element of the claimed invention must be identically shown in a single reference, but this is not an "ipsissimis verbis" test. In re Bond, 910 F.2d 831, 832, 15 USPQ2d 1566, 1567 (Fed. Cir. 1990). The claims measure the invention. SRI Int'l v. Matsushita Elec. Corp., 775 F.2d 1107, 1121, 227 USPQ 577, 585 (Fed. Cir. 1985) (en banc). In view of 12 appellant's choosing to draft the claims in an open-ended, "comprising" form, we are not persuaded of error in our determination that the elements set forth as in instant claim 1, under the broadest reasonable interpretation of the terms, fail to distinguish over the structures disclosed by Scifres. The reference describes distinct portions of 12 layer 25 separated by strain layer 27. The claims are sufficiently broad to read on the portion of layer 25 between the strain layer and the active region as depicted in Figure 2 of the reference.

Contrary to appellant's indication in the request, we did not ignore any description in Scifres that provides "a distance of 0.05μm as to that part of 25 that is

between 27 and 29" and that the reference indicates "cladding layer thicknesses to be typically about 1µm." Scifres teaches that strain layer 27 in Figure 2 is typically at least 0.5µm away from the active region. Col. 5, ll. 16-24. The reference's teaching with respect to the 0.5µm distance thus indicates a lower bound for distance of the strain layer from the active region, rather than a requirement of 0.5µm distance. Moreover, the cladding layer thicknesses described as "typically about 1µm thick" refer to cladding layers 13 and 17 in the separate embodiment of Figure 1. Col. 3, ll. 39-56.

We thus were, and remain, unconvinced that the relevant Scifres structures shown in Figure 2 do not fall within the broad terms of "approximately equal layer thickness" as recited in instant claim 1. Scifres' Figure 1 shows layers 13 and 17 equal in thickness, consistent with the written description at column 3, lines 55 and 56 of the reference. Appellant's arguments as to why we should consider the relevant layers of Figure 2 as something different from "approximately equal layer thickness" are contrary to an appreciation of all the teachings of the reference. Moreover, whether the reference teaches the relevant layers as being of "equal" layer thickness is not at issue, in view of appellant's choice of language setting forth the alleged distinction.

Appellant also alleges that we disregarded claim language, in view of our opinion not quoting all relevant limitations at the top of page 5. We did not disregard limitations, but simply referred to the relevant limitations -- using fewer than all the words -- by speaking of the Scifres structure as protecting the hetero-configuration from crystal defects "as claimed" (emphasis added). As for the asserted lack of explaining our

reasoning, we direct attention to page 4 of the opinion where we referred to the examiner's specific findings in the Answer, and noted the broadening language of claim 1 relative to crystal defects, neither of which appellant has shown to represent error.

Appellant also submits that we erred in failing to denominate the affirmance as a new ground of rejection, as provided for by 37 CFR § 1.196(b). A rejection must be considered "new" if the appellant has not had a fair opportunity to react to the thrust of the rejection. In re Kronig, 539 F.2d 1300, 1302, 190 USPQ 425, 426 (CCPA 1976).

We believe it apparent that our reference to appellant's description of the prior art in the instant disclosure did not represent a new finding necessary for affirming the rejections, but merely pointed out that appellant's record is inconsistent with a position advanced in the brief.

Contrary to appellant's implication, we do not consider our finding at page 6 of the opinion that Scifres taught "a second dense defect layer," and that the teaching of Inoue for the addition of a second dense defect layer could be considered merely cumulative, as changing the thrust of the rejection. That the references taught a second dense defect layer as claimed was the thrust of the rejection applied against claims 2 and 8. Moreover, we did not disagree with the examiner's findings with respect to the teachings of the respective references.

Finally, appellant asserts that the decision made "no attempt" to answer the "specific arguments" at pages 14-15 of the brief in defense of claim 8. The answer to the arguments is found at page 7, first full paragraph of the opinion, where we pointed

out that appellant's reasoning was based on the alleged disparity in teachings between the Inoue and Scifres references. We further pointed out that, for the same reasons with respect to why we found the combination of Scifres and Inoue as applied against claim 2 to be proper, we found appellant's position with respect to claim 8 to be untenable.

We have thus granted appellant's request to the extent of reconsidering the decision mailed February 19, 2002. However, we deny the request with respect to making any changes therein.

No time period for taking any subsequent action in connection with this appeal may be extended under 37 CFR § 1.136(a).

DENIED

JERRY SMITH
Administrative Patent Judge

JOSEPH F. RUGGIERO
Administrative Patent Judge

HOWARD B. BLANKENSHIP
Administrative Patent Judge

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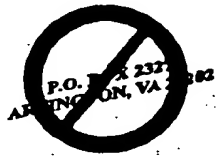

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